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Atty Dkt No. GP-302713 (GM-0360PUS)

Remarks

This Amendment is intended to be fully responsive to the Office Action mailed July 19, 2004. Claims 1-18 are pending. Claims 19-30 are withdrawn. The Examiner rejects claims 1, 2, 5, 6, and 14 under 35 U.S.C. § 102(b) as being anticipated by Moore et al., United States Patent No. 5,934,745. Furthermore, the Examiner rejects claims 3 and 7-13 under 35 U.S.C. § 103(a) as being unpatentable over Moore et al. Finally, the Examiner rejects claims 1, 4 and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Heim et al., United States Patent No. 6,102,470, in view of Moore et al.

Rejections under Section 102(b)

The Examiner finds that Moore et al. disclose:

a rear and side panel assembly for a vehicle comprising a one-piece inner body panel member (14) mated with a one-piece outer body panel member (12), said body panel members cooperating to at least partially define wheel well openings (52,40) for opposing sides (front and back) of the vehicle.

Applicants submit that it is well understood in the art that "sides" of a vehicle mean left and right sides – the "front" and "back" of a vehicle are not understood to be "sides". Thus, the "opposing sides" of claim 1 should not be interpreted as encompassing the "front and back" of the vehicle.

In any event, Applicants have amended claim 1 to recite that "each of the body panel members at least partially defines wheel well openings on opposing sides of the vehicle." This amendment clarifies that the wheel well openings must be on the opposing sides (i.e., a wheel well opening on the left side and a wheel well opening on the right side). Thus, even under the Examiner's counterintuitive use of "front and back" as "opposing sides", Moore et al.'s inner body panel member 14 and outer body panel member 12 each define wheel well openings on only one side of the vehicle (either the left side or the right side). Moore et al. do not disclose:

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a one-piece inner body panel member mated with a one-piece outer body panel member, said body panel members cooperating such that each of said body panel members at least partially defines wheel well openings on opposing sides of the vehicle[,]

as required by amended claim 1. Thus, amended claims 1 and claims 2, 5, 6 and 15 which depend therefrom are not anticipated by Moore et al. and the rejection under Section 102(b) is believed to be overcome.

Rejection under Section 103(a) over Moore et al.

The Examiner finds claims 3 and 13 to be obvious under Section 103(a) in light of the disclosures of Moore et al. As provided by Section 2143.03 of the MPEP:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S. C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 Fx.2d 107a, 5 USPQ 2d 1596 (Fed. Cir. 1988).

As discussed above with respect to the rejection of claim 1 under Section 102(b), Moore et al. do not disclose the following recited elements and limitations of claim 1:

a one-piece inner body panel member mated with a one-piece outer body panel member, said body panel members cooperating such that each of said body panel members at least partially defines wheel well openings on opposing sides of the vehicle.

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Thus, because Moore et al. do not anticipate claim 1, claims 3 and 13 which depend from claim 1 cannot be obvious under Section 103(a) in view of Moore et al. Accordingly, the rejection of claims 3 and 13 is believed to be overcome. Additionally, Moore et al. do not teach that:

the inner body panel member is formed from a first rigid sheet and the outer body panel is formed from a second rigid sheet[,]

as required by claim 2. On the contrary, Moore et al. teach that:

The four body panels, 12, 14, 16, and 18, may be formed by molding, e.g., injection molding, a polymeric material such as a plastic composite material. Thus, each body panel is a single piece and all the features shown on each of the body panels in FIG. 2 are integral.

(col. 3, lines 53-57)

The only forming process taught by Moore et al. is plastic molding. Plastic molding results in a single piece for each of Moore et al.'s body panels 12, 14, 16, and 18 – but Moore et al. do not teach that the panels are “formed from a single sheet” (emphasis added) as required by claim 2. Thus, Moore et al. do not “disclose the rear and side panel assembly of claim 2”, as stated by the Examiner. For this reason also, claim 3, which depends from claim 2, cannot be obvious.

Even assuming, *arguendo*, that Moore et al. disclose the recited structure of claims 1 and 2, it would not be obvious to one of ordinary skill in the art that the “first and second sheets are aluminum” as required by claim 3, which depends from claim 2. Similarly, it would not be obvious that “the [one-piece] inner body panel member and the [one-piece] outer body panel member are aluminum” as required by claim 13. Moore et al. teach that:

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Being molded, the thickness of the various features on the body panels may be easily controlled as desired. ... In contrast, if the body panels and features are stamped from sheet metal, the thickness of the various features is not as easily controlled. In addition, when made from a polymeric material, the weight of the motor vehicle body of the present invention may be lower than traditional vehicle bodies.

(col. 4, lines 10-18)

Thus, Moore et al. teach away from the use of a metal sheet (such as an aluminum sheet) for forming the body panels 12, 14 of Moore et al., both because of difficulty in achieving final desired characteristics and because of undesirable weight. Thus, it would not be obvious to one skilled in the art based on the teachings of Moore et al. to form one-piece inner and outer body panels from aluminum a required by claims 3 and 13. For this reason also, claims 3 and 13 are not obvious in view of Moore et al. and the rejection of these claims under Section 103(a) is believed to be improper.

The Examiner rejects claims 7-12 as being obvious under Section 103(a), stating that:

The rear and side panel assembly is anticipated by Moore et al. as modified. The process by which the rear and side panel assembly is made is not a patentable distinction.

As discussed above, the rear and side panel assembly of claim 1, from which claims 7-12 depend, is not anticipated by Moore et al. (nor, as discussed below, is it obvious from Moore et al.). Accordingly, the following language of MPEP 2113 cited by the Examiner is not satisfied by the Moore et al. reference:

If the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made from a different process.

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For this reason, the rejection of claims 7-12 under Section 103(a) in light of Moore et al. is improper.

Rejection under Section 103(a) over Heim et al. in view of Moore et al.

The Examiner rejects claims 1, 4 and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Heim et al. in view of Moore et al. The Examiner finds a "rear and side panel assembly" in Figure 1 of Heim et al. It is presumed that the Examiner refers to the closing module 6 of Figure 1. Heim et al. teach that:

With respect to the closing module 6, it holds that a lower frame runner 31 of the rim 7 of the closing module 6 runs above the side members 23 of the shell body 1, that a preassembled collision member 32 which includes the crash-boxes 24 on both sides is attached to the lower frame runner 31 of the rim 7 and that the crash-boxes 24 are screwed directly to the side members 23. In both embodiments, the collision member 32, as is known, consists of an outer plastic bumper 33, an energy absorber 34, which accommodates smaller impacts with back deformation, a metallic bumper transverse member 35 and the two aforementioned crash-boxes 24 which establish the connection of the transverse member of the bumper 35 to the faces of the side members 23 of the shell body 1.

(col. 5, lines 60-67; col. 6, lines 1-6)

Thus, the closing module 6 of Heim et al. clearly consists of a multitude of components and, as the Examiner admits, "Heim et al. do not disclose that the rear and side panel assembly is made from an inner panel and an outer panel." However, the Examiner looks to "Moore et al. [which] disclose a rear and side panel assembly which is made from an inner panel and an outer panel" and finds that "it would have been obvious to combine Moore et al. with Heim et al. to obtain the invention as specified in claims 1, 4 and 15-18." The Examiner states that "[t]he motivation [to combine the references] would have been to make the rear and side body assembly with a low number of parts." However, Heim et al. do not provide a motivation to reduce the number of

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parts in their closing module 6. Furthermore, the vehicle disclosed in Moore et al. would increase in parts if it incorporated a rear and side panel assembly like that of the present invention (i.e., one that "at least partially defines wheel well openings on opposing sides of the vehicle" as required by claim 1"). Accordingly, Applicant respectfully submits that the obviousness rejections are improper because there would have been no motivation or suggestion for a person of ordinary skill in the art at the time of Applicant's invention to combine the cited references. The Federal Circuit makes clear that the best defense against the subtle but powerful attraction of impermissible "hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." In re Dembicza, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999). See also, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.2d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically ...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (evidence of teaching or suggestion "essential" to avoid hindsight); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297, 227 USPQ 657, 667 (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination"). See also Graham, 383 U.S. at 18, 148 USPQ 467 ("strict observance" of factual predicates to obviousness conclusion required). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint to piecing together the prior art to defeat patentability—the essence of hindsight. See, e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."). For at least these reasons, the rejection of claims 1, 4 and 15-18 over Heim et al. in view of Moore et al. is believed to be overcome.

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Conclusion

In light of the amendment to claim 1 and the above remarks, the rejections under Section 102(b) and 103(a) are believed to be overcome. Accordingly, claims 1-18 are believed to be allowable, which action is respectfully requested.

Respectfully submitted,

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